

REMARKS/ARGUMENTS

In the specification, the paragraph on Page 8, lines 20-33 has been corrected. Line 28 erroneously referred to Figure 8C. It should refer to Figure 8D.

Independent claims 1 and 7 have been amended to overcome a rejection for indefiniteness under 35 U.S.C. 112. The negative limitation "without grooves" has been replaced with language that positively claims the structure of the metal jacket in accordance with the specification.

Having corrected the grounds for rejection under 35 U.S.C. 112, the applicant believes the claims 1, 2, and 4-7 are now allowable. Applicant respectfully request reconsideration of the rejection based on 35 U.S.C. 103(a) for the following reasons.

As the examiner has pointed out, the U.S. patent, No 5,528,989, to Briese ("Briese") discloses a highly separable bullet which "has a jacket 12 which encloses and constrains the bullet core 11 and provides a shape." Col. 5, lines 28-30. In addition Briese discloses a "plurality of malleable strands of metal." Col. 4, line 64. However, Briese does not disclose the helically formed spiral claimed by the applicant.

The helical structure claimed by the applicant would not be anticipated by Briese, not only because of the significant difference in structure, but also because, on impact, the helically wound strands cause the bullet to perform differently than the kinked strands disclosed in Briese. An important benefit of the applicant's claimed invention is the improved separation of the strands into a multitude of fragments as opposed to the limited number of fragments obtained from the Briese bullet. Compare in Applicant's drawings the pattern of Fig. 7C with that of Fig. 8D.

The Examiner contends that combining the teachings of Briese, as discussed, with the teachings of the British patent to Weiss, No. 11,087, ("Weiss") is sufficient to render the applicant's invention obvious under 35 U.S.C. § 103. Applicant courteously disagrees with the Examiner for the following reasons. It is Applicant's position that the structure and function of the instant bullet differs from that of Briese when viewed in the light of

the British patent, and further that there would be no motivation to combine these teachings in an attempt to approximate Applicant's invention.

In the Weiss patent, the core b₁ of Fig. 3 consists of several pieces of lead wire or the like twisted together, and then pressed into the open rear end of a weakened mantel having internal or external grooves. The forward end of the mantel is closed and pointed.

In Applicant's invention, on the other hand, the core of spiral strands is swaged and inserted into the open forward end of a jacket that is closed at its rear end, the jacket being subsequently closed at its forward end to define a point. Applicant's cylindrical jacket is not internally or externally grooved, but rather has a uniform thickness throughout its length and has a uniform smooth inner and outer circumferential surface.

The object of the Weiss patent "is to render impossible the ricocheting frequently occurring during shooting practice on ranges by causing the projectile to burst on impact with a hard body after passing through the target in the usual manner." (Page 1, lines 5-9). Weiss specifically claims a projectile in which "the interior or exterior of the mantle is provided with *grooves or recesses*." Pg. 1, lines 41-42 [emphasis added]. The Weiss patent fails to give any indication that its use could lead to a key benefit of the applicant's invention, namely the improved "damage track" as discussed in Pg. 8, lines 24-34 of the specification and shown in Fig. 8D. Weiss teaches in Claim 1 that both the mantle and the core should be weakened such that the bullet could not possibly function in a way similar to the applicant's invention. Thus, there would be no teaching, suggestion or motivation to combine the teaching of Briese with those of the British patent to produce Applicant's invention. As stated by the Court of Appeals for the Federal Circuit in In re Sang Su Lee, 277 F 3d 1338; 61 USPQ 2d 1430 (Fed. Cir. 2002):

"When patentability turns on the question of a obviousness, the search for an analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness."

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Applicant respectfully contends that the necessary motivation is missing by a combination of the Briese and Weiss patents. Furthermore, in the absence of any "substantial evidence" of record, there is no indication in Briese or in Weiss that the combination of the two references could be used to achieve the effect of the applicant's invention. In In re Werner Kotzab, 217 F. 3d 1365, 55 USPQ 2d 1313 (Fed. Cir. 2000), the Court of Appeals for the Federal Circuit reversed the Board of Appeals' finding of obviousness saying:


Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.

It is not sufficient that the elements in the prior art can be combined; there must be, in the record, some motivation to combine the prior art elements. Absent this motivation in the record, the applicant courteously submits that the applicant's present invention is not obvious over the prior art.

Favorable action is courteously solicited.

Respectfully submitted,

11/13, 2003


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